

REMARKS

In the Final Action of July 11, 2008 Claims 31–33, 37–38 and 45–47 were rejected under 35 U.S.C. 103(a) as being unpatentable over de Halleux U.S. Patent 4,569,229, while the remaining Claims 34–36, 39 and 48–50 were objected to as being dependent upon a rejected base claim, but were indicated as being allowable if rewritten into independent form. The remaining Claims 40–44 were withdrawn from consideration as being drawn to a non-elected invention.

Favorable reconsideration of the application is respectfully requested in the light of the foregoing amendments and the following remarks, as it is believed that the entry of these amendments will result in the allowance of the rejected claims, thereby placing the application in condition for allowance.

With regard to independent Claims 31 and 45, rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over de Halleux, it is to be noted that the propriety of a rejection under 35 U.S.C. 103 has been established by many Court decisions; see for example National Tractor Pullers Assn., Inc. v. Watkins 205 USPQ 892 wherein the Court stated (on Page 911):

“The test of obviousness under 35 U.S.C. 103 is not whether a prior art device could be modified into something resembling the applicant’s structure, but the proper test is whether, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art, given the teachings of the prior art, to make the invention. Graham v. John Deere, 383 US 1.148 USPQ 459 (1965). In considering the prior art, prior patents are references only for what they clearly disclose or suggest and it is not proper to modify their structure in a manner which is not suggested by prior art. In re Randol and Redford, 425 F.2d 1286, 165 USPQ 586 (CCPA 1970)” A modification of a prior art patent or device which would render that device unworkable for its intended purpose cannot be said to suggest such a modification. Diamond International Corp. v. Walterhoefer, 289 Fig. Supp. 550, 159 USPQ 452 (D.C. Md. 1968); Ex parte Weber, 154 USPQ 491 (P.O.Bd.Ap. 1967). (Underlining added.)

It is submitted that this test, as to the propriety of a rejection under 35 U.S.C. 103, does not support the rejection by the Examiner of Claims 31 and 45 on this reference.

Thus, as correctly noted by the Examiner, de Halleux discloses a process for measuring stress in a bolt by measuring the transit time of acoustical waves. The

Examiner attempts to read Claims 31 and 45 on such a construction wherein there is utilized "a ratchet or any similar tool for gripping the screw head as a first point, and the tool handle spaced apart from a first point, as a second point where the force is being applied by a person's hand". It is submitted that the above reasoning is not consistent with the requirements of 35 U.S.C. 103, as set forth above, and therefore these independent Claims 31 and 45, as previously presented, are allowable over this reference.

Nevertheless, in order to avoid an Appeal, the above amendments amend independent Claims 31 and 45 to include the subject matter of previously-presented Claims 32 and 46. Such an amendment to the claims would even further distinguish over the cited reference in a number of important respects:

First, amended Claims 31 and 45 are now limited to the feature that the connecting body is a fastening plate which fastens the first member to the second member, to distinguish over the "bolt" in the cited reference.

Secondly, the independent claims now require that the first and second members are rotary members fastened for rotation together about a common axis of rotation by the fastening plate, which is not present in the cited reference.

Thirdly, the claims as so amended now require that the force measured is the torque applied by the first rotary member to the second rotary member by fastening plate, to distinguish over the axial force produced in the bolt of the cited reference.

It is submitted, therefore, that independent Claims 31 and 45, as amended, are now clearly allowable over the cited reference.

Claims 32 and 46 have been cancelled, as their subjects matter have been introduced into independent Claims 31 and 45.

Claims 33-38 all depend from amended Claim 31 and are therefore submitted to be allowable with that claim for the same reasons as discussed above, apart from the further features included in the respective dependent claims. In this respect, it is to be noted that the subjects matter of dependent Claims 34-36 have already been indicated as being allowable.

Claim 39 was also indicated as including allowable subject matter and was indicated as being allowable if rewritten in independent form. Accordingly, Claim 39 has been rewritten in independent form, and is therefore considered to be allowable.

The remaining claims under consideration, namely Claims 47–50, all depend from Claim 45, and are therefore believed to be allowable with that claim for the same reasons, in addition to the further features set forth in the respective dependent claims. In this connection, it is to be noted that subjects matter of dependent Claims 48–50 have already been indicated as being allowable.

In view of the foregoing, it is believed these amendments will place the application in condition for allowance, and therefore the entry of these amendments is requested for this purpose.

If, however, the Examiner is still of the opinion that the main independent claims are not allowable even when amended as proposed above, it is respectfully requested that the amendments nevertheless be entered for purposes of Appeal as simplifying the issues to be decided on Appeal. Since the amendments merely in effect cancel previous independent Claims 31 and 45, and rewrite dependent Claims 32 and 46 in independent form, the entry of these amendments will certainly not introduce any new issues, or require any further search, and therefore no reason is seen why their entry should be refused for purposes of Appeal.

In any event, since the application is under Final, an early response is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Martin D. Moynihan".

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